

02 JUN 2003



UNITED STATES PATENT and TRADEMARK OFFICE

#4

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Volpe and Koenig, P.C.
Suite 400, One Penn Center
1617 John F. Kennedy Boulevard
Philadelphia, PA 19103

In re Application of	:	DECISION ON
Lehmann et al	:	
PCT No.: PCT/EP00/03860	:	PETITION UNDER
Int. Filing Date: 28 April 2000	:	
Priority Date: 06 May 1999	:	37 CFR 1.47(a)
Attorney's Docket No.: SMB-PT036	:	
For: DEVICE FOR PERFORMING ANALYSES	:	
ON CELL-CULTURES	:	

This is in response to the "PETITION UNDER 37 CFR §1.47(a) TO ACCEPT DECLARATION ON BEHALF OF INVENTOR WHO REFUSES TO SIGN" filed on 07 November 2002. The \$130.00 petition fee has been paid by check.

BACKGROUND

On 28 April 2000, applicants filed international application PCT/EP00/03860. A copy of the international application was communicated by the International Bureau to the United States Patent and Trademark Office on 30 November 2000. A DEMAND was filed on 17 November 2000 prior to the expiration of 19 months from the priority date electing the United States. Accordingly, the thirty month (30) time period for paying the basic national fee in the United States of America expired at midnight on 06 November 2001.

On 05 November 2001, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee. No executed oath or declaration from the inventors accompanied the Transmittal Letter. A copy of the intentional application was transmitted on 30 November 2000 to the USPTO from the International Bureau.

On 07 May 2002, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date" must be submitted within two months from its 07 May 2002 date of mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 30 September 2002, applicants filed the present petition accompanied, inter alia, an executed Declaration without the signature of WOLF, Bernhard.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the

application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1) of 37 CFR 1.47(a). However, requirement (2) – (4) have not been satisfied.

Regarding requirement (2), the averments of the petition are insufficient to support a finding that the nonsigning inventor, WOLF, Bernhard refuses to sign, and also petitioner does not appear to have first hand knowledge of the facts alluded to by the petition as required by MPEP Section 409.03(d). Moreover, petitioner has not demonstrated that a complete copy of the application papers were sent to the nonsigning inventor. In this case, it has not been sufficiently demonstrated that a complete copy of the application papers were presented to the nonsigning inventor. Petitioners have provided no proof to corroborate that a complete application was sent (specification, including claims, drawings, and oath or declaration) since only the declaration was mentioned as being sent to Mr. Wolf. In addition, petitioner has not submitted copies of documentary evidence such as a copy of the registered returned envelope, a certified mail return receipt, a cover letter instructions, and etc., as required by MPEP Section 409.03 to support petitioner's allegation.

Petitioner needs to submit statements, with specific facts on the actions referred to by the last paragraph of the petition by persons who have first-hand knowledge of such facts.

Regarding requirement (3), petitioner has not provided a statement of the last known address of the missing inventor.

Regarding requirement (4), the declarations provided with the above application are defective since they do not comply with 37 CFR 1.497(a)(3). A Declaration, under 37 CFR 1.497(a)(3), must identify each inventor. See MPEP § 602. In this instance, petitioner submitted

a composite declaration comprising of various sets of declarations that are incomplete since each set must be complete by naming each inventor. It appears that petitioner just added pages from various declarations to make one declaration. For example there is one page that indicates "page 2 of 2," three pages that indicate "page 3 of 4," and one page of "page 4 of 4."

Petitioner must submit complete sets of declarations if a single declaration does not have all the signatures of the signing inventors.

Consequently, the petition does not include sufficient factual proof that Mr. Wolf refused to sign the required documents.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459



Leonard Smith
PCT Legal Examiner
PCT Legal Office